REMARKS/ARGUMENTS

Applicants thank the Examiner for her careful review and analysis of the claims as embodied in the Office Action mailed December 30, 2005. By way of this paper, Applicants propose to amend certain dependent claims to correct minor clerical and grammatical errors. No new matter is added by the proposed amendments, and the changes do not touch the substance of even the dependent claims that are amended. The sole independent claim, claim 1, is not proposed to be amended so no new issue is presented here and the amendments should be entered even if the rejection is maintained. Applicants also request favorable reconsideration in view of the following Remarks.

Claims 1-12 remain rejected as unpatentable over SmartDraw.com ("SmartDraw UML: How to Draw UML Diagrams," hereinafter "SmartDraw") in view of Apfelbaum et al. (US Patent No. 6,853,963, hereinafter "Apfelbaum"). In the prior Response, the Applicants noted a number of reasons that the cited combination of references failed to teach the claimed invention. In addition to those comments, which are incorporated here by reference, Applicants respectfully submit the following comments as well.

In summary, Applicants respectfully submit that (a) the SmartDraw reference is not prior art, (b) the SmartDraw reference does not teach the elements for which it is asserted, and (c) the combination of SmartDraw and Apfelbaum is not supported by motivation in the art as required for a proper obviousness rejection.

Initially, Applicants note that while the Apfelbaum reference predates the present application filing date, the SmartDraw reference was published too late to qualify as prior art. In particular, the date on the SmartDraw publication is April 27, 2005, which is the print-out date. The text of the print-out indicates that it was published sometime after Windows XP became available. Indeed, almost all of the components of the printout have 2005 copyright dates. Moreover, there has been no evidence that the technology described in the printout was identically available prior to Applicants' filing date.

Although the SmartDraw program may have existed for some time, there is no evidence or documentation to suggest that the SmartDraw reference embodies the exact functionality available at all stages of the life cycle of that software. In other words, the SmartDraw of 2001 will inevitably differ from the SmartDraw of 2005. Accordingly, it is respectfully submitted that the SmartDraw reference is not prior art nor is there any

assurance that it actually describes a prior art system. Since SmartDraw forms the basis of the rejection of each claim, favorable reconsideration of all claims is requested.

Moreover, regardless of the status of SmartDraw as prior art, it is respectfully submitted that the combination of SmartDraw and Apfelbaum fails to teach or even suggest every limitation of the sole independent claim, claim 1. Applicants previously noted that the state set editing means disclosed in SmartDraw edits the states of a class in an object-oriented programming language (see page 16 of Smartdraw). By contrast, the present invention claims a state set editing means that adds and deletes states of a composite display part. The states and behavior of a graphic, such as the composite display part, are fundamentally different from the states and behavior of an object-oriented programming language. Applicants further noted that SmartDraw discloses an object class whereas the present invention claims a composite display part. It was noted that a class of an object-oriented programming language is not displayed as part of a user interface and that SmartDraw fails to teach or suggest *a user interface designed by a user interface designing apparatus*. Instead, SmartDraw discloses a UML state diagram designed by UML state diagram designing software.

In the subject Office Action, the Office responds as follows: "if we examined the teachings of SmartDraw as a flowchart diagram, the flowchart will be presented to the user on a display device, and the user is allowed to further make changes to the flow chart by adding/deleting objects from the diagram." However, even assuming for the sake of argument that SmartDraw provides a flow chart diagram that is presented to the user so that the user can edit objects via the graphical interface, this feature still fails to teach the invention claimed.

Claim 1 pertains to a "user interface designing apparatus." SmartDraw does not describe a user interface designing apparatus. At most, the reference merely implies a user interface for editing objects, not for actually *designing user interfaces*.

Claim 1 also recites that "the composite display part is displayed to a user as part of a user interface designed by the user interface designing apparatus." The SmartDraw system may support a display of objects, but those display elements are not themselves composite display parts having states. Rather, those display elements are just graphical representations of *internal* elements (i.e., objects) that are being exposed to the user in

graphical form for editing. Moreover, any such display of objects was not itself "part of a user interface designed by the user interface designing apparatus."

As a further example, claim 1 recites means for "adding/deleting elementary display parts to be displayed in each of the states of the composite display part." There is nothing in SmartDraw that teaches this functionality. The SmartDraw objects represent system functions, for example, "Print" (*see* p. 12). The Print function and any associated objects are not elementary display parts nor are they composite display parts, in fact, they are not display parts at all.

Moreover, not only is SmartDraw lacking any element corresponding to the elementary display part storing means of claim 1, SmartDraw also lacks any element corresponding to the state display editing means. These two added functionalities provide the user interface designing apparatus of the invention which determines which elementary display parts should be displayed as the user interface when the objects are executed. These elementary display parts for the user interface may be buttons, labels, text inputting forms, check boxes, menus, panels, and frames. SmartDraw is unable to determine which of these elementary display parts should be displayed. SmartDraw's technical ideas for designing state transitions cannot describe nor suggest designing a user interface by adding or deleting elementary display parts with respect to a composite display part which corresponds to an object.

Not only does the cited combination of references fail to teach the claim elements, the combination is itself improperly made. In order to support the combination of references, the Office Action states the following:

> Apfelbaum teaches ...[that the] state machine includes a plurality of states. Therefore it would have been obvious ...to allow the usage of a plurality of states in a state model [as per Apfelbaum] ***in a system which suggests the usage of a plurality of states*** as taught by SmartDraw ...***for providing the user with a desirable interface*** for interacting with the system.

However, this statement of motivation is based on erroneous assumptions, two of which will be addressed here.

First, on page 4, the Office Action notes that SmartDraw ***fails*** to teach the use in the system of a plurality of states. However, the statement of motivation quoted above

contradicts this observation and states that SmartDraw "suggests the usage of a plurality of states."

Second, once that erroneous statement is removed, there is nothing left tying the teachings of Apfelbaum to those of SmartDraw other than a general statement that it would be good to provide a user "with a desirable interface." Applicants do not disagree that their claims describe a desirable invention, but the simple fact that an invention is desirable or useful does not make the invention obvious when nothing in the references actually suggests the combination that is the invention.

Finally, with respect to Apfelbaum, that patent neither describes nor suggests either of the elementary display part storing means or the state display editing means of claim 1. Thus, even if SmartDraw were modified with Apfelbaum, the invention of claim 1 could not be produced.

Summing up Applicants' comments regarding claim 1, the SmartDraw reference is not prior art, nor does it teach the elements for which it is asserted. Moreover, the combination of SmartDraw and Apfelbaum is not supported by any motivation in the art as required for a proper obviousness rejection. Moreover, the hypothetical combination, if made, would not produce the claimed invention. Thus, claim 1 is patentable over the art of record. Regarding dependent claims 2-12, these claims are patentable for at least the same reasons as claim 1.

Accordingly, favorable reconsideration of the claims and withdrawal of the outstanding rejections are respectfully requested.

Respectfully submitted,

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